

BEST AVAILABLE COPY

MP



✉ EPA/EPO/DEB
D-80299 München

☎ +49 89 2399-0
TX 523 858 opmu d
FAX +49 89 2399-4465

Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Generaldirektion 2

Directorate General 2

Direction Générale 2

Mikulecky, Klaus, Dr.
Clariant Service GmbH
Patente, Marken, Lizenzen
Am Unisys-Park 1
65843 Sulzbach
ALLEMAGNE

Clariant GmbH
Patente, Marken, Lizenzen

Akte / Vorg.

Eing. 20. Jan. 2004

☐ Wv

☐ ablegen

☐ vertellan

Telephone numbers:

Primary Examiner
(substantive examination) +49 89 2399-8835

Formalities Officer / Assistant
(Formalities and other matters) +49 89 2399-8081



Application No. 02 023 437.3 - 2108	Ref. 2001US406	Date 19.01.2004
Applicant CLARIANT INTERNATIONAL LTD.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



VAYSSIE S F P
Primary Examiner
for the Examining Division


Enclosure(s): 4 page/s reasons (Form 2906)

T-ART	FRIST
BEI	29.05.04

W

K

Registered Letter
EPO Form 2001 07.02CSX

	Bescheld/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
	Datum Date Date	Blatt Sheet Feuille	Anmelde-Nr. Application No.: Demande n°:
	19.01.2004	1	02 023 437.3

The examination is being carried out on the following application documents:

Text for the Contracting States:

AT BE CH CY DE DK ES FI FR GB GR IE IT LU MC NL PT SE TR CZ EE BG SK LI

Description, pages:


1-15 as originally filed

Claims, No.:

1-9 as received on 21.10.2003 with letter of 20.10.2003

1. The following documents cited in the Search Report are referred to in this communication:

- D1: US-B1-6 258 365 (LEGROW GARY E ET AL) 10 July 2001 (2001-07-10)
- D2: EP-A-0 862 913 (OREAL) 9 September 1998 (1998-09-09)
- D3: US-B1-6 184 277 (BARA ISABELLE) 6 February 2001 (2001-02-06)
- D4: WO 96 40044 A (PROCTER & GAMBLE) 19 December 1996 (1996-12-19)
- D5: US-A-5 225 188 (SCHULZ JR WILLIAM J ET AL) 6 July 1993 (1993-07-06)
- D6: WO 99 09947 A (ELLIOTT RUSSELL PHILIP ;PHIPPS NICOLA JACQUELINE (GB); COFFINDAFFE) 4 March 1999 (1999-03-04)
- D7: US-A-5 968 490 (GALLEGUILLLOS RAMIRO ET AL) 19 October 1999 (1999-10-19)
- D8: US 2001/018068 A1 (LORENZI MARC PAUL ET AL) 30 August 2001 (2001-08-30)
- D9: US-A-5 972 318 (BARA ISABELLE) 26 October 1999 (1999-10-26)
- D10: EP-A-0 756 864 (OREAL) 5 February 1997 (1997-02-05)
- D11: US-A-5 885 559 (LEE WILSON ET AL) 23 March 1999 (1999-03-23)
- D12: EP-A-1 216 683 (BEIERSDORF AG) 26 June 2002 (2002-06-26)
- D13: WO 00 15180 A (HERCULES INC) 23 March 2000 (2000-03-23)
- D14: US-A-5 942 216 (SUN WEI MEI ET AL) 24 August 1999 (1999-08-24)
- D15: EP-A-0 850 644 (OREAL) 1 July 1998 (1998-07-01)
- D16: EP-A-0 850 643 (OREAL) 1 July 1998 (1998-07-01)
- D17: WO 01 12152 A (PROCTER & GAMBLE) 22 February 2001 (2001-02-22)
- D18: US-A-5 413 781 (GIWA-AGBOMEIRELE PATRICIA ET AL) 9 May 1995 (1995-05-09)

	Beschheid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
	Datum Date Date	Blatt Sheet Feuille	Anmelde-Nr.: Application No.: Demande n°:
	19.01.2004	2	02 023 437.3

09)

D19: WO 97 16161 A (UNILEVER PLC ;UNILEVER NV (NL)) 9 May 1997 (1997-05-09)

2. Objections under Article 52(1) EPC and major ob!Use Claims 1-2Clarity

The subject-matter of Claim 1 is not clear, because the signification for a) and b) is wider in the description than in the claim, because for a) the description also includes resins (not only oils, page 3, line 21) and for b) it also includes semisolids like waxes (not only oils, page 4, line 11). This wider signification was taken into consideration for the assessment of patentability.

Therefore, the application does not meet the requirements of Article 84 EPC.

Novelty of independent Claim 1

For the purpose of examination, the wording "compatibilization" has been understood as "obtention of a clear or homogeneous mixture" (page 6, line 18).

The present invention does not meet the requirements of Article 54 EPC, because the subject-matter of Claim 1 is not new. See:

D1-D19: the relevant passages have already been indicated on the Search Report by the present Substantive Examiner acting as a Search Examiner.

Article 56 objection: if the Applicant files an amended independent claim containing a new technical feature, he is also requested to indicate in his letter of reply the inventive contribution thereof to the state of the art as compared to the subject-matter of the unamended claim and to substantiate his arguments, for instance by filing relevant comparative tests (with and without this new feature).

3. The Applicant is requested to file new claims which take account of the above comments (see



Bescheld/Protokoll (Anlage)

Communication/Minutes (Annex)

Notification/Procès-verbal (Annexe)

Datum
Date
Date

19.01.2004

Blatt
Sheet
Feuille

3

Anmeld-Nr.:
Application No.:
Demande n°:

02 023 437.3

also formal objections of paragraph 4 below, as far as they relate to the claims).

4. Should an amended application be filed, the following points should also receive attention:

4.1 Objection under Article 82 EPC

The application lacks unity a posteriori within the meaning of Article 82 EPC for the following reasons:

Grounds for objection:

The separate inventions/groups of inventions are indicated in the annex to the Search Report.

The common concept linking together these inventions (Article 82 EPC) is the following:
use of organomodified silicone c), modified with R group, wherein
R is an alkyl or alkenyl radical having 6-40 carbon atoms, a phenyl radical, an alkylaryl radical having 7-30 carbon atoms or an arylalkyl radical having 7-30 carbon atoms
x is an integer between 1 and 10
y is an integer between 1 and 10
v, z are integers between 1 and 100,
for the compatibilization of silicone oils a) and organic oils b) in mixtures comprising silicone oils a) and organic oils b)
with the proviso that the silicone oils a) are not organomodified silicones c) according to the formulae (1), (2) or (3).

Lack of novelty of the general concept:

This single general inventive concept is known in the art, see:
D1-D19: see 2.

Note: still, the most reliable indication of lack of unity in the present case lies in the fact that at least one of the alternative embodiments of the invention lacks novelty (and this applies of course still more to their common concept), see 2.

Lack of inventive step of the general concept:



Bescheid/Protokoll (Anlage)

Communication/Minutes (Annex)

Notification/Procès-verbal (Annexe)

Datum
Date
19.01.2004

Blatt
Sheet
Feuille
4

Anmelde-Nr.:
Application No.:
Demande n°:
02 023 437.3

The technical problem solved by the invention was thus to provide a composition with improved compatibilization properties (see application, page 2, lines 5-7). This technical problem was already solved in D1-D19 (see above).

Therefore, the general concept does not involve an inventive step either.

Legal consequences:

The general concept is neither novel, nor does it involve an inventive step. Thus, a technical relationship involving one or more of the same or corresponding special technical features in the sense of Rule 30 EPC does not exist between these inventions. Unity of invention must therefore be denied.

Since the applicant has not indicated on which invention searched by the Search Division the further prosecution of the application should be based, no further prosecution can be carried out for the time being (cf. the Guidelines, C-III, 7.11). The applicant is asked to state upon which invention further prosecution of this application should be based and to limit the application accordingly. Other inventions are to excised from the claims, description and drawings if any.

The subject-matter to be excised may be made the subject of one or more divisional applications. The divisional applications must be filed directly at the European Patent Office in Munich or its branch at The Hague and in the language of the proceedings relating to the present application, cf. Article 76(1) and Rule 4 EPC. The time limit for filing divisional applications (Rule 25(1) EPC) must be observed.

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.